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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,067	06/25/2003	Yoshiyuki Ando	YA05	1066

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EXAMINER	
GROSSO, HARRY A	

ART UNIT	PAPER NUMBER
3727	

DATE MAILED: 06/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/604,067	ANDO, YOSHIYUKI	
	Examiner	Art Unit	
	Harry A. Grosso	3727	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 March 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) *3-7,10,11,14,15 and 19* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2, 8,9, 12, 13, 16-18 and 20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Claim Rejections - 35 USC § 102

> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

1. Claims 1, 8, 9, 12, 16 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Borin (3,858,767).

2. Borin discloses a plastic container (column 1, line 39) with a lip (20, Figures 1-5) and vertical projections (36) with a horizontal upper surface that would prevent the lip from contacting a surface on which the container is inverted. There are two projections spaced-apart by the lip and a slot (70). The cross-section of the container is a circle.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Borin. Borin discloses the invention except for the height of the projection. Applicant requires a height of about 1 to about 3 mm above the lip but does not discloses that these dimensions are for any particular purpose or solve any stated problem. The container of Borin would be inherently capable of performing in the same manner as the container of claim 1. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the use of a projection with a height of about 1 to about 3 mm in the container disclosed by Borin to provide it with adequate height to prevent the lip from contacting the surface. In Gardner v. TEC Systems, Inc., 725 F. 2d

1338, 220 USPQ 777 (fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of the relative dimensions of a claimed device and a device having claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

5. Claims 2 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borin in view of Florian (4,049,187).

6. Regarding claim 2, Borin discloses the invention of claim 2 except for a handle. Florian discloses a foam plastic cup with a handle (Figures 1-6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the use of a handle as disclosed by Florian in the cup disclosed by Borin to provide for a better way to hold the cup (column 1, lines 8-13).

7. Regarding claim 18, Borin discloses the invention except for the handle and the height of the projection. Florian disclosed the use of the handle as discussed in paragraph 6 and the height of the projections is addressed in paragraph 4 above.

8. Claim 20 rejected under 35 U.S.C. 103(a) as being unpatentable over Borin. Borin discloses a container that can be considered a drinking glass with a circular cross section, a sealed base, an open top, a lip and projections as discussed above. Borin does not teach the height of the projections. Applicant requires a height of about 1 to about 3 mm above the lip but does not discloses that these dimensions are for any particular purpose or solve any stated problem. The container of Borin would be inherently capable of performing in the same manner as the container of claim 1. It

would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the use of a projection with a height of about 1 to about 3 mm in the container disclosed by Borin to provide it with adequate height to prevent the lip from contacting the surface. In Gardner v. TEC Systems, Inc., 725 F. 2d 1338, 220 USPQ 777 (fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of the relative dimensions of a claimed device and a device having claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Response to Arguments

9. Applicant's arguments filed March 15, 2006 have been fully considered but they are not persuasive. Applicant argues Borin does not have two spaced-apart projections. In response, vertical projections (36) are two projections spaced-apart by the lip and a slot (70).

10. In response to applicant's argument that the projections of Borin are not intended to support the inverted cup, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

11. Applicant argues that the dimensions recited in claim 13 are adequate to prevent the lip of the inverted cup from touching the surface that the cup is resting on and thus are for a particular purpose. In response, the dimensions recited are adequate to

accomplish the intended purpose but are not required to accomplish that purpose. Projections having other dimensions would be equally capable of performing the function. The relative dimensions of the projections is not a patentably distinct feature.

12. Applicant argues that it is not obvious to use Florian's handle on Borin's cup because Borin's cup is molded from an insulating foam-type plastic. In response, Florian teaches an integral handle on a cup made from insulating foam-type plastic, foamed polystyrene (column 2, lines 20-22). Thus, addition of Florian's handle to the cup of Borin would be obvious from Florian's invention and provide means for holding the cup without touching the outer walls.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harry A. Grosso whose telephone number is 571-272-

4539. The examiner can normally be reached on Monday through Thursday from 7am to 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Newhouse can be reached on 571-272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nathan Newhouse
Supervisory Patent Examiner
Art Unit 3727

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